

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Confirmation No.: 4858
Scott Baggs Group Art Unit: 2878
Serial No.: 09/885,900 Examiner: Yam, Stephen K.
Filed: June 20, 2001 Docket No. 10004919-1
For: SPACE SAVING FLATBED SCANNER

SUBSTITUTE APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This substitute appeal brief is sent in response to a communication mailed June 22, 2007. This substitute brief is substantively identical to the original Appeal Brief, but has updated the summary section, in accordance with the June 22, 2007, communication.

This is an appeal from the decision of Examiner Yam, Stephen K., Group Art Unit 2878, mailed September 27, 2005, rejecting claims 1-13, 15-34, 36, 40-43, 45-72, 74, and 75 in the present application and making the rejection FINAL.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is Hewlett-Packard Development Company, a Texas Limited Liability Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claim 1-77 are pending in this application. Claims 1-13, 15-34, 36, 40-43, 45-72, 74, and 75 were rejected by the FINAL Office Action, and are the subject of this appeal. Claims 37-39 were allowed, and claims 14, 35, 44, 73, 76, and 77 were indicated to be allowable. The Office Action rejected claims 1, 2, 8, 16, 17, 26, 32, 40-43, 55, 56, 59, 64, 70, and 75 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent 6,433,941 to *Onoda* (hereafter *Onoda*). The Office Action rejected claims 3, 9, 19, 27, 45, 58, and 65 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of elements from U.S. Patent 6,331,886 to *Nagano et al.* (hereafter *Nagano*). The Office Action rejected claim 15 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* in view of *Nagano*. The Office Action rejected claims 4, 28, 46, and 66 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of elements from JP2000-209408 to *Minowa* (hereafter *Minowa* '408). The Office Action rejected claims 5, 6, 10-12, 18, 20, 29, 30, 33, 47-51, 57, 67, 68, and 71 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of elements from U.S. Patent 6,408,161 to *Minowa* '161). The Office Action rejected claims 7, 13, 31, 34, 36, 52-54, 69, 72, and 74 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda*. Finally, the Office Action rejected claims 21-25 and 60-63 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda*.

and a selective combination of elements from *Minowa* '161 further in view of *Minowa* '048.

IV. STATUS OF AMENDMENTS

All amendments submitted before the mailing date of the FINAL Office Action have been entered, and no amendments have been submitted subsequent to the mailing of the FINAL Office Action. A copy of the current claims is attached hereto as Appendix A.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the claimed subject matter are illustrated in FIGs. 2 through 10 and are discussed in the specification at least at pages 5-16.

Embodiments of the invention, such as those defined by claim 1, define a space-saving scanner assembly (see e.g., reference numeral 100 and at least FIGs. 3-10 and related discussion), comprising a housing (see e.g., reference numeral 300 and at least FIGs. 3-10 and related discussion, including p. 7, lines 15-27) having a substantially vertical source-contact surface with a member forming a channel (see e.g., reference numeral 330 and at least FIGs. 3-10 and related discussion, including p. 8, line 30 through p. 9, line 21) that protrudes from the housing, said member having a first side that is substantially parallel to, and opposed from, said source-contact surface (see e.g., reference numerals 300 and 305 related discussion, including p. 8, lines 18-29), said member having a second side substantially orthogonal to the first side, wherein the member extends to an exterior surface of said housing. The assembly further comprises a flap (see e.g., reference numeral

310 and at least FIGs. 3-10 and related discussion, including p. 9, line 12 through p. 10, line 12) coupled to the source-contact surface, the flap having a source-backing surface (see e.g., reference numeral 320 and at least FIGs. 3-10 and related discussion, including p. 8, line 30 through p. 9, line 12) substantially parallel to the source-contact surface of the housing 300, wherein the source-contact surface, the source-backing surface, and the first and second sides of the member form an aperture for receiving an edge of a source (see e.g., reference numeral 350 and at least FIGs. 3-10 and related discussion) to be scanned.

Embodiments of the assembly, such as those defined by claim 3, define a front panel of the housing comprises an inclined surface 417 adjacent to the aperture. (see e.g., at least reference number 417 in FIG. 4 and related discussion).

Embodiments of the assembly, such as those defined by claim 5, define the flap to comprise a slot. (see e.g., at least reference numeral 316 and FIGS. 6 and 8, and related discussion).

Embodiments of the assembly, such as those defined by claim 15, define the member to be coated with a layer of material having a relatively low coefficient of friction. (see e.g., at least specification p. 9, lines 7-8).

Embodiments of the invention, such as those defined by claim 16, define space-saving scanner assembly (see e.g., reference numeral 100 and at least FIGs. 3-10 and related discussion), comprising means for housing (see e.g., reference numeral 300 and at least FIGs. 3-10 and related discussion, including p. 7, lines 15-27) an optical scanning means; and means for forming an aperture (see e.g., aperture formed between inclined surfaces 417, 419 of FIG. 4 and related discussion, including p. 11, lines 31-31) configured to closely receive a leading edge

of a source (see e.g., reference numeral 350 and at least FIGs. 3-10 and related discussion), such that the source can be spatially arranged with the optical scanning means without adjusting the aperture (see e.g., reference number 316 identifying a notch to be used for adjusting the source, as described on at least p. 12, lines 22-31), the source being supported along a horizontal edge different from the leading edge of said source along a channel means (see e.g., reference numeral 330 and at least FIGs. 3-10 and related discussion, including p. 8, line 30 through p. 9, line 21) in the aperture.

Embodiments of the invention, such as those defined by claim 20 define a method for saving space on a desktop, comprising: providing an optical scanner (see e.g., reference numeral 100 and at least FIGs. 3-10 and related discussion) having a housing (see e.g., reference numeral 300 and at least FIGs. 3-10 and related discussion, including p. 7, lines 15-27), the housing having a substantially vertical source-contact surface (see e.g., reference numerals 300 and 305 related discussion, including p. 8, lines 18-29) with a member forming a channel (see e.g., reference numeral 330 and at least FIGs. 3-10 and related discussion, including p. 8, line 30 through p. 9, line 21) protruding from the housing; and coupling a flap (see e.g., reference numeral 310 and at least FIGs. 3-10 and related discussion, including p. 9, line 12 through p. 10, line 12) to the source-contact surface (see e.g., reference numerals 300 and 305 related discussion, including p. 8, lines 18-29), the flap having a slot extending to an edge of the flap and source-backing surface (see e.g., reference numeral 320 and at least FIGs. 3-10 and related discussion, including p. 8, line 30 through p. 9, line 12) substantially parallel to the source-contact surface of the housing, wherein the source-contact surface, the source-backing surface, and the

member form an aperture (see e.g., aperture formed between inclined surfaces 417, 419 of FIG. 4 and related discussion, including p. 11, lines 31-31) for horizontally receiving a source (see e.g., reference numeral 350 and at least FIGs. 3-10 and related discussion) to be scanned.

Embodiments of the invention, such as those defined by claim 26, define a space-saving scanner assembly (see e.g., reference numeral 100 and at least FIGs. 3-10 and related discussion), comprising: a housing (see e.g., reference numeral 300 and at least FIGs. 3-10 and related discussion, including p. 7, lines 15-27) having a substantially vertical source-contact surface (see e.g., reference numerals 300 and 305 related discussion, including p. 8, lines 18-29); a member forming a channel (see e.g., reference numeral 330 and at least FIGs. 3-10 and related discussion, including p. 8, line 30 through p. 9, line 21) protruding from the housing; and a flap (see e.g., reference numeral 310 and at least FIGs. 3-10 and related discussion, including p. 9, line 12 through p. 10, line 12) coupled to the housing, the flap having a source-backing surface (see e.g., reference numeral 320 and at least FIGs. 3-10 and related discussion, including p. 8, line 30 through p. 9, line 12) substantially parallel to the source-contact surface of the housing, wherein the source-contact surface, the source-backing surface, and the member form an aperture (see e.g., aperture formed between inclined surfaces 417, 419 of FIG. 4 and related discussion, including p. 11, lines 31-31) for horizontally receiving a source (see e.g., reference numeral 350 and at least FIGs. 3-10 and related discussion) to be scanned without necessitating relative movement between the flap and the housing.

Embodiments of the invention, such as those defined by claim 40 define a space-saving scanner assembly (see e.g., reference numeral 100 and at least FIGs. 3-10 and related discussion), comprising: a housing (see e.g., reference numeral 300 and at least FIGs. 3-10 and related discussion, including p. 7, lines 15-27), having a substantially vertical source-contact surface (see e.g., reference numerals 300 and 305 related discussion, including p. 8, lines 18-29); a flap (see e.g., reference numeral 310 and at least FIGs. 3-10 and related discussion, including p. 9, line 12 through p. 10, line 12) coupled to the source-contact surface, the flap having a source-backing (see e.g., reference numeral 320 and at least FIGs. 3-10 and related discussion, including p. 8, line 30 through p. 9, line 12) surface substantially parallel to the source-contact surface of the housing; and a support member interposed between said housing and said flap and extending to a front panel of the housing, wherein the source-contact surface, the source-backing surface, and said support member form an aperture (see e.g., aperture formed between inclined surfaces 417, 419 of FIG. 4 and related discussion, including p. 11, lines 31-31) for horizontally receiving a source to be scanned without necessitating relative movement between the flap and the housing.

Embodiments of the invention, such as those defined by claim 55, define a space-saving scanner assembly (see e.g., reference numeral 100 and at least FIGs. 3-10 and related discussion), comprising: means for housing (see e.g., reference numeral 300 and at least FIGs. 3-10 and related discussion, including p. 7, lines 15-27) an optical scanning means; and means for forming an aperture (see e.g., aperture formed between inclined surfaces 417, 419 of FIG. 4 and related discussion, including p. 11, lines 31-31) configured to closely receive a leading edge

of a source (see e.g., reference numeral 350 and at least FIGs. 3-10 and related discussion) transferred horizontally along a plane substantially orthogonal to a front surface of the means for housing, such that the source can be spatially arranged with the optical scanning means without adjusting the aperture, the source being supported along a second edge of said source by a support means in the aperture, said support means extending to a front panel of the means for housing, wherein said support means is interposed between a first source-retaining means and said optical scanning means.

Embodiments of the invention, such as those defined by claim 59 define a method for saving space on a desktop, comprising: providing an optical scanner (see e.g., reference numeral 100 and at least FIGs. 3-10 and related discussion) within a housing (see e.g., reference numeral 300 and at least FIGs. 3-10 and related discussion, including p. 7, lines 15-27), the housing having a substantially vertical source-contact surface (see e.g., reference numerals 300 and 305 related discussion, including p. 8, lines 18-29) with a support member protruding from the housing, the support member extending to the exterior of the housing; and providing a flap (see e.g., reference numeral 310 and at least FIGs. 3-10 and related discussion, including p. 9, line 12 through p. 10, line 12) closely coupled to the source-contact surface, the flap, support member, and source-contact surface forming an aperture (see e.g., aperture formed between inclined surfaces 417, 419 of FIG. 4 and related discussion, including p. 11, lines 31-31) for receiving a source moved horizontally to be scanned.

Embodiments of the invention, such as those defined by claim 75 define a method for arranging a source (see e.g., reference numeral 350 and at least FIGs. 3-10 and related discussion) in a scanner (see e.g., reference numeral 100 and at least FIGs. 3-10 and related discussion) comprising: horizontally inserting a leading edge of the source into an aperture (see e.g., aperture formed between inclined surfaces 417, 419 of FIG. 4 and related discussion, including p. 11, lines 31-31) formed by a support member interposed between a platen and a flap (see e.g., reference numeral 310 and at least FIGs. 3-10 and related discussion, including p. 9, line 12 through p. 10, line 12) such that a surface of the source having information thereon that is desired to be imaged by the scanner is adjacent to a sensor arranged in a substantially vertical plane; and adjusting the source (see e.g., reference number 316 identifying a notch to be used for adjusting the source, as described on at least p. 12, lines 22-31) such that the information desired to be imaged is aligned with the sensor.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Office Action rejected claims 1, 2, 8, 16, 17, 26, 32, 40-43, 55, 56, 59, 64, 70, and 75 under 35 U.S.C. § 102(e) as allegedly anticipated by *Onoda*.

The Office Action rejected claims 3, 9, 19, 27, 45, 58, and 65 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of elements from U.S. Patent 6,331,886 to *Nagano*.

The Office Action rejected claim 15 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* in view of *Nagano*.

The Office Action rejected claims 5, 6, 10-12, 18, 20, 29, 30, 33, 47-51, 57, 67, 68, and 71 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of elements from *Minowa* '161.

The Office Action rejected claim 15 under 35 U.S.C. § 103(a) as allegedly obvious over *Onoda*.

VII. ARGUMENT

The Rejection of Claims 1, 2, 4, 7-8, 13, 16, 17, 26, 28, 31-32, 34, 36, 40-43, 46, 52-56, 59-64, 66, 69, 70, 72, 74, and 75 Should be Overturned

The Office Action rejected claims 1, 2, 8, 16, 17, 26, 32, 40-43, 55, 56, 59, 64, 70, and 75 under 35 U.S.C. § 102(e) as allegedly anticipated by *Onoda*. For at least the reasons set forth below, Applicant submits that the rejections are erroneous and should be overturned.

Claim 1 (the exemplary claim of this group) recites:

1. A space-saving scanner assembly, comprising:
a housing having a ***substantially vertical source-contact surface*** with a member forming a channel that protrudes from the housing, said member having a first side that is substantially parallel to, and opposed from, said source-contact surface, ***said member having a second side substantially orthogonal to the first side***, wherein the member extends to an exterior surface of said housing; and
a flap coupled to the source-contact surface, ***the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, wherein the source-contact surface, the source-backing surface, and the first and second sides of the member form an aperture for receiving an edge of a source to be scanned.***

(*Emphasis added.*) Claim 1 patently defines over *Onoda* because *Onoda* fails to disclose at least the features emphasized above.

First, Applicant notes that, in order for *Onoda* to be a proper anticipatory

reference, “**the invention** [must be] described in … a patent granted on an application for patent by another…” 35 U.S.C. § 102(e) (*Emphasis added.*) In forming the rejection of claim 1 (Office Action, page 3, first paragraph), the Examiner has mixed and matched components from FIGs. 2B and 3 (an embodiment of the invention of *Onoda*) with the different invention of FIG. 6, which is designated as “prior art” to the invention of *Onoda*. With regard to the prior art embodiment of FIG. 6, this embodiment is substantially unrelated to the embodiments of the presently claimed invention, as the embodiment of FIG. 6 (of *Onoda*) is directed to a horizontally-disposed scanner, as opposed to a vertically-disposed scanner of embodiments of the present invention (the horizontal orientation of the scanner of FIG. 6 is readily verified by the underlying support surface in *Onoda*, which is designated by cross-hatching). As the components within *Onoda* that are being combined are from two independent “inventions” (one prior art to the other), then “the invention” is not described in *Onoda*, and the corresponding rejection under 35 U.S.C. § 102 is misplaced and should be overturned.

More specifically, the Office Action (p. 3, first paragraph) rejected claim 1 stating:

... Onoda teaches (see Fig. 2B, 3, 6, 7, 8) a space-saving scanner assembly, comprising a housing (3) having a substantially vertical source-contact surface (10) with a member (21) forming a channel (along (21a) bounded by (21a)(24), and (10)) that protrudes from the housing (see Fig. 2B), said member having a first side (24) that is substantially parallel to, and opposed from, said source-contact surface, said member having a second side (21a) substantially orthogonal to the first side (see Fig. 2B), and a flap (40) coupled to the source-contact surface (see Fig. 3 and 6), the flap having a source-backing surface (facing (10)) substantially parallel to the source-contact surface of the housing (See Fig. 4), ***wherein the source-contact surface, the source-backing surface, and the first and second sides of the member form an aperture (gap bounded by (40), (10), and (21)- see Fig. 6 for receiving an edge (edge of***

**(P) contacting (21a) in Fig. 2B) of a source (P) to be scanned
(see Fig. 2B).**

(Emphasis added.) As noted above, the rejection is improper under 35 U.S.C. § 102(e) as it combines features from different inventions (one being prior art to the other), and as such does not properly disclose “the invention” as required by 35 U.S.C. § 102. In addition, the Examiner relied upon the teachings of FIG. 6 of Onoda to reject claim 1, stating that the elements 40, 10, and 21 define the claimed “aperture.” Applicant disagrees.

Claim 1 defines the “member” as “having a second side substantially orthogonal to the first side...” The Examiner cites element 21 of Onoda as constituting the claimed “member” and element 21a as constituting the second side of the member. However, as is clear from zoomed portion of the illustration in FIG. 6, the edge 21a is NOT substantially orthogonal to any other edge of that element. Instead, the edge 21a is disposed at an oblique angle (which appears to be an angle of approximately 45°) to the other edges of that element. Further, and as mentioned above, FIG. 6 of Onoda discloses a horizontal scanner (confirmed by the cross-hatching that designates the support surface). For at least these reasons, the rejections of claim 1 are misplaced and should be overturned.

As the other independent claims (claims 16, 26, 40, 55, 59, 64, and 75) were rejected based on the same reference and under similar rationales, the rejections of these claims should be overturned as well. Further, claims 2, 8, 17, 32, 41-43, 56, and 70 each depend from one of the foregoing dependent claims and should be allowed for at least the same reasons as claim 1.

The Office Action rejected claims 4, 28, 46, and 66 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of

elements from *Minowa* '408. Applicant disagrees with this rejection, and the combination of *Minowa* '408 with *Onoda*. Notwithstanding, each of these claims depends from one of the independent claims listed above. Therefore, the rejection of each of these claims should be overturned for at least the same reason set forth above in connection with claim 1.

The Office Action rejected claims 7, 13, 31, 34, 36, 52-54, 69, 72, and 74 under 35 U.S.C. § 103(a) as allegedly obvious over *Onoda*. Applicant disagrees with this rejection. Notwithstanding, each of these claims depends from one of the independent claims listed above. Therefore, the rejection of each of these claims should be overturned for at least the same reason set forth above in connection with claim 1.

The Office Action rejected claims 60-63 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of elements from *Minowa* '161 further in view of *Minowa* '048. Applicant disagrees with this rejection. Notwithstanding, each of these claims depends from independent claim 59 listed above. Therefore, the rejection of each of these claims should be overturned for at least the same reason set forth above in connection with claim 1.

The Rejection of Claims 3, 9, 19, 27, 45, 58, and 65 Should be Overturned

The Office Action rejected claims 3, 9, 19, 27, 45, 58, and 65 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of elements from U.S. Patent 6,331,886 to *Nagano*. The rejections are erroneous and should be overturned.

Claim 3 (the representative claim) recites:

3. The assembly of claim 1, wherein a front panel of the housing comprises an ***inclined surface adjacent to the aperture.***

The Office Action rejected claim 3 (and the other claims of this group) stating:

“... *Onoda* teaches the device and method in the parent claims, according to the above rejection.... *Onoda* does not teach a front panel of the housing comprising an inclined surface adjacent to the aperture, the inclined surface forming a wider opening at the surface of the front panel... *Nagano* teach (see Fig. 13 and 14) a similar device and method with a vertical scanner and horizontally receiving a source (into (203a)) into an aperture (203a), with a front panel (202) of a housing (201) comprising a first inclined surface (left inclined portion of (203) next to (203a)) adjacent to the aperture, the inclined surface forming a wider opening for the aperture at the surface of the front panel (see Fig. 13), with a second inclined surface (right inclined portion of (203) next to (203a)) associated with the first source retaining means.

(Office Action, page 9, paragraph 5, lines 3-15). *Nagano* teaches no such thing.

Instead, reference number 203 in *Nagano* designates a “door” (not an “inclined portion” as claimed) for changing the size of a film inserting slot of a scanner body. Significantly, the sides of 203 are stepped and not inclined. In this regard, FIGS. 13 and 14 include lines (although not specifically designated by a separate reference number) that illustrate a stepped (e.g., approximately 90°) portion, rather than a beveled or “inclined” portion, as specifically claimed by claim 3. Furthermore, the entire discussion of FIGs. 13 and 14 in *Nagano* states:

FIG. 13 is a perspective view showing the film scanner according to the third embodiment. In FIG. 13, reference numeral 201 denotes the film scanner body, reference numeral 202 denotes a front cover, reference numeral 203 denotes a door for changing the size of a film inserting slot, reference numeral 203a denotes a first film inserting slot, and reference numeral 204 denotes a lid for covering the inserting slot 203a. Furthermore, reference numeral 206 denotes a power switch, and reference numeral 207 denotes an LED lamp indicating that a power supply is turned on. Reference numeral 205 denotes a mounting portion for temporarily attaching thereto the lid 204 removed.

FIG. 14 is a diagram showing a state where a slide-mounted film is inserted into the film scanner body 201, and, also when the

slide-mounted film is about to be removed from the film scanner body 201, this state also occurs.

As can be readily verified, there is no teaching here of an “inclined portion,” and as can be readily verified and understood from FIGS. 13-14, there is no teaching or disclosure of the front cover 203 as having an “inclined portion.”

It is well-established that the terms of a claim are given their ordinary meaning unless it appears that the inventor intended to use them differently. Watts v. XL Systems, Inc., 232 F.3d 877 (Fed. Cir. 2002). Webster’s Ninth New Collegiate Dictionary (1983), in pertinent part, defines “inclined” as “having a leaning or slope,” and defines “inclined plane” as “a plane surface that makes an oblique angle with the plane of the horizon.” Consistent with this ordinary meaning, the present application illustrates the claimed “inclined portion” (reference number 417) in FIG. 4 (among other figures), and describes its structure and function in the corresponding portions of the specifications. As illustrated, the claimed “inclined portion” of the housing is a bevel that forms an oblique angle with the housing, consistent with the ordinary meaning, as confirmed by the definition in Webster’s Dictionary. Suffice it to say that the “inclined portion” of Applicant’s claimed embodiments is significantly different than the “door” of *Nagano*, as applied by the Office Action, and as such the rejections of the corresponding claims are misplaced.

As reference number 203 of *Nagano* does not comprise an inclined portion adjacent to the aperture, as alleged by the Office Action, the application of *Nagano* in rejecting claims 3, 9, 19, 27, 45, 58, and 65 is clearly misplaced, and these rejections should be overturned.

As a separate and independent basis for the patentability of these claims, Applicant respectfully submits that the Examiner has failed to cite a proper

motivation for combining the *Onoda* and *Nagano* references. It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a space-saving scanning system and method as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was is motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *Gambro Lundia AB*, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, No 98-1553 (Fed. Cir. January 27, 2000).

In the rejecting claim 3 (and the other claims of this group), the Office Action alleged:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a front panel of the housing comprising a first inclined surface adjacent to the aperture with the inclined surface forming a wider opening for the aperture at the surface of the front panel, and provide the second inclined surface, as taught by Nagano et al. in the device and method of Onoda, **to provide easier insertion and removal of sources into the scanner. Since the aperture of Onoda is bounded by the housing**

on one side and the flap on the other, modifying the device of Onoda with the teachings of Nagano would provide one inclined surface on the housing and the other inclined surface on the flap.

(*Emphasis added.*) This *alleged* motivation embodies clear hindsight reasoning, as the reason advanced by the Examiner is based on a perceived beneficial, after-the-fact result. Simply stated, the motivation to combine Nagano with Onoda, which was relied upon by the Examiner conflicts with well-established Federal Circuit precedent, and as such is improper and the rejection of claim 3 (and the other claims of this group) should be overturned.

The Rejection of Claim 15 Should be Overturned

The Office Action rejected claim 15 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and *Nagano*. The rejection is erroneous and should be overturned. Claim 15 depends from claim 9, which in turn depends from claim 3, which depends from claim 1. As discussed above, claims 3 and 9 were both rejected under 35 U.S.C. § 103(a) as allegedly obvious over *Onoda* and a selective combination of elements from *Nagano*.

Previously the Examiner had rejected claim 15 based solely on *Onoda*. In response to a previous appeal brief (which noted the impropriety of such a rejection – as the secondary reference, *Nagano*, was relied upon to reject the base claims), the Examiner reopened prosecution and mailed the outstanding FINAL Office Action. (see Office Action, page 10-11).

The rejection of claim 15 should be overturned for at least the same reason as the rejection of base claim 9. In addition, Applicant respectfully traverses the combination of *Nagano* with *Onoda*, in the context of the claimed subject matter of

claim 15. The Examiner as alleged that the combination would have been obvious because it is allegedly “well known in the art to use materials with relatively low coefficient of friction to facilitate the insertion and removal of objects into slots.” Applicant respectfully submits that this rationale embodies improper hindsight reasoning or is otherwise contra to the well-established law (relevant to the motivation to combine under 35 U.S.C. § 103(a), which was set forth above. For at least this additional reason, the rejection of claim 15 should be overturned.

The Rejections of Claims 5, 6, 10-12, 18, 20-25, 29, 30, 33, 47-51, 57, 67, 68, and 71 should be overturned

The Office Action rejected claims 5, 6, 10-12, 18, 20, 29, 30, 33, 47-51, 57, 67, 68, and 71 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of elements from *Minowa* ‘161. The rejections are erroneous and should be overturned.

Claim 5 (the representative claim) recites: “5. The assembly of claim 1, wherein the flap comprises a slot.” The Office Action rejected claim 5 (and the other claims) claims stating:

“... *Onoda* teaches the device and method in the parent claims, according to the above rejection. *Onoda* does not teach the flap comprising a slot, wherein the slot is positioned to permit the placement of a relatively short document on edge on ... *Minowa* ‘161 teaches (see Fig. 8 and 10) a similar device and method, with ... a flap (130), wherein the flap comprises a slot (in (139)), ... (see Col. 8, lines 56-58) ... (see Col. 8, lines 61-65)..."

(Office Action, page 11, lines 4-12). *Minowa* ‘161 teaches no such thing. Instead, reference number 139 in *Minowa* ‘161 designates an “inner cover” (not a slot), and it includes “a lever or knob 139a” (*Minowa* ‘161, col. 8, lines 22-23). The portions of *Minowa* ‘161 cited by the Office Action (col. 8, lines 56-58 and 61-65) actually state:

... With the inner cover 139 thus opened, the user can set a document into the space between the inner cover 139 and the glass plate 112. ... The document set into this space is automatically registered as it moves by its own weight so that one of its edges abuts the document guide 138b; this ensures that the document will be correctly positioned with respect to the glass plate 112.

As can be readily verified, there is no teaching here of the claimed “slot,” and as can be readily verified and understood from FIGS. 7-10, there is no teaching or disclosure of the inner cover 139 as comprising a “slot.”

It is well-established that the terms of a claim are given their ordinary meaning unless it appears that the inventor intended to use them differently. Watts v. XL Systems, Inc., 232 F.3d 877 (Fed. Cir. 2002). Webster’s Ninth New Collegiate Dictionary (1983), in pertinent part, defines “slot” as “a narrow opening or groove... a narrow passage or enclosure.” Consistent with this ordinary meaning, the present application illustrates the claimed slot in FIGS. 6 and 8 (see reference numeral 316), and describes its structure and function in the corresponding portions of the specifications. Suffice it to say that the “slot” of Applicant’s claimed embodiments is significantly different than the “inner cover” of *Minowa* ‘161, as applied by the Office Action, and as such the rejections of the corresponding claims are misplaced.

As reference number 139 of *Minowa* ‘161 does not comprise a slot, as alleged by the Office Action, the application of *Minowa* ‘161 in rejecting claims 5, 6, 10-12, 18, 20, 29, 30, 33, 47-51, 57, 67, 68, and 71 is clearly misplaced, and these rejections should be overturned.

As a separate and independent basis for the patentability of these claims, Applicant respectfully submits that the Examiner has failed to cite a proper motivation for combining the *Onoda* and *Minowa* ‘161 references. The relevant legal

precedent regarding rejections under 35 U.S.C. § 103(a) has been set forth about in connection with the discussion of claim 3, and is repeated and realleged herein.

In the rejecting claim 5 (and the other claims of this group), the Office Action alleged:

It would have been obvious to one of ordinary skill in the art at the time the invention was made ***to provide the flap comprising a slot, wherein the slot is positioned to permit the placement of a relatively short source document on edge on the member such that information to be scanned is aligned with at least a portion of the platen, as taught by Minowa '161 in the device of Onoda, to provide additional access to the scanning area without excessive component movement, for increased convenience.***

(*Emphasis added.*) This *alleged* motivation embodies clear hindsight reasoning, as the reason advanced by the Examiner is based on a perceived beneficial, after-the-fact result. Further, the rationale is based on a purely subjective perception (i.e., that the combination would provide “increased convenience.”) If such a rationale were acceptable, it would permit Examiners to reject virtually every patent claim submitted for consideration by the PTO. Instead, the developed legal precedence regarding rejections under 35 U.S.C. § 103(a) require objective teachings within the prior art that would lead an artisan to combine selective components from multiple references. Simply stated, the motivation to combine *Minowa '161* with *Onoda*, which was relied upon by the Examiner, conflicts with well-established Federal Circuit precedent, and as such is improper and the rejection of claim 5 (and the other claims of this group) should be overturned.

The Office Action rejected claims 21-25 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of *Onoda* and a selective combination of elements from *Minowa '161* further in view of *Minowa '048*. Applicant respectfully disagrees. Notwithstanding, each of these claims depends from claim 20, which was listed

above in the group related to claim 5 (the exemplary claim). Therefore, the rejection of each of these claims should be overturned for at least the same reason set forth above in connection with claim 5.

CONCLUSION

Based upon the foregoing discussion, Applicant respectfully requests that the Examiner's final rejection of claims 1-13, 15-34, 36, 40-43, 45-72, 74, and 75 be overturned by the Board, and that the application be allowed to issue as a patent with all pending claims 1-77.

In addition to the claims of Appendix A, Appendix B attached hereto indicates that there is no evidence being submitted in connection with this Appeal Brief, and Appendix C attached hereto indicates that there are no related proceedings.

No additional fees are believed to be due in connection with this Substitute Appeal Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 08-2025.

Respectfully submitted,

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VIII. CLAIMS - APPENDIX

1. A space-saving scanner assembly, comprising:
a housing having a substantially vertical source-contact surface with a member forming a channel that protrudes from the housing, said member having a first side that is substantially parallel to, and opposed from, said source-contact surface, said member having a second side substantially orthogonal to the first side, wherein the member extends to an exterior surface of said housing; and
a flap coupled to the source-contact surface, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, wherein the source-contact surface, the source-backing surface, and the first and second sides of the member form an aperture for receiving an edge of a source to be scanned.
2. The assembly of claim 1, wherein a portion of the vertical source-contact surface of the housing comprises a platen to permit scanning of a source document in a vertical position.
3. The assembly of claim 1, wherein a front panel of the housing comprises an inclined surface adjacent to the aperture.
4. The assembly of claim 1, wherein the flap comprises an inclined surface adjacent to the aperture.
5. The assembly of claim 1, wherein the flap comprises a slot.
6. The assembly of claim 1, wherein the source-backing surface of the flap comprises a clip arranged to receive a portion of a source document to be scanned.
7. The assembly of claim 1, wherein the housing further comprises a recess configured to receive a portion of the member when an operator closely adjusts the source contact surface to the substantially vertical surface of the housing.

8. The assembly of claim 2, wherein the platen has an upper edge, an opposing lower edge, a front edge relatively coexistent with a front panel of the housing, and a distal edge and wherein the member is adjacent to the lower edge of the platen.

9. The assembly of claim 3, wherein the member has a first end proximal to the front panel of the housing and a distal end that extends at least to an edge of the platen.

10. The assembly of claim 4, wherein the flap is coupled to the housing with at least one post assembly having a plurality of spatially separated detent positions.

11. The assembly of claim 4, wherein the flap is coupled to the housing with at least one adjustable fastener for closely contacting the source-backing surface to the vertical source-contact surface.

12. The assembly of claim 5, wherein the slot is positioned to permit the placement of a relatively short source document on edge on the member such that information to be scanned is aligned with at least a portion of a platen.

13. The assembly of claim 7, wherein the housing is configured to extend the member away from the vertical source-contact surface when an operator adjusts the source-backing surface in relation to the vertical source-contact surface of the housing to increase the width of the aperture.

14. The assembly of claim 2, wherein the width of a first end of the member proximal to a front panel of the housing increases over a portion of the length of the member.

15. The assembly of claim 9, wherein the member is coated with a layer of material having a relatively low coefficient of friction.

16. A space-saving scanner assembly, comprising:
means for housing an optical scanning means; and
means for forming an aperture configured to closely receive a leading edge of a source, such that the source can be spatially arranged with the optical scanning means without adjusting the aperture, the source being supported along a horizontal edge different from the leading edge of said source along a channel means in the aperture.
17. The assembly of claim 16, wherein a source retaining means of said channel means extends vertically from a base of said channel means.
18. The assembly of claim 16, wherein the means for forming an aperture comprises a flap having a slot.
19. The assembly of claim 16, wherein the means for forming an aperture comprises a first inclined surface associated with a housing and a second inclined surface associated with a flap.
20. A method for saving space on a desktop, comprising:
providing an optical scanner having a housing, the housing having a substantially vertical source-contact surface with a member forming a channel protruding from the housing; and
coupling a flap to the source-contact surface, the flap having a slot extending to an edge of the flap and source-backing surface substantially parallel to the source-contact surface of the housing, wherein the source-contact surface, the source-backing surface, and the member form an aperture for horizontally receiving a source to be scanned.
21. The method of claim 20, further comprising inserting a leading edge of a source to be scanned into the aperture formed by the source-contact surface, the source-backing surface, and the member such that a horizontal edge of the source different from the leading edge is supported along the member.

22. The method of claim 21, further comprising spatially arranging the flap and the housing wherein pressure is applied to a non-scan surface of the source and the scan surface of the source closely contacts the transparent platen portion.

23. The method of claim 22, further comprising enabling the optical scanner to scan the source.

24. The method of claim 23, further comprising spatially arranging the flap and the housing wherein pressure is removed from the non-scan surface of the source.

25. The method of claim 24, further comprising removing the source from the aperture.

26. A space-saving scanner assembly, comprising:
a housing having a substantially vertical source-contact surface;
a member forming a channel protruding from the housing; and
a flap coupled to the housing, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, wherein the source-contact surface, the source-backing surface, and the member form an aperture for horizontally receiving a source to be scanned without necessitating relative movement between the flap and the housing.

27. The assembly of claim 26, wherein the housing contains a front panel with an inclined surface adjacent to the aperture, the inclined surface forming a wider opening at the surface of the front panel.

28. The assembly of claim 26, wherein the flap comprises an inclined surface adjacent to the opening, the inclined surface arranged to increase the opening along a front edge of the flap, wherein the front edge is substantially perpendicular to the source-backing surface.

29. The assembly of claim 26, wherein the flap comprises a slot.
30. The assembly of claim 29, wherein the slot is positioned to permit the placement of a relatively short source document on edge on said member and wherein information to be scanned from the source document is aligned with at least a portion of a platen.
31. The assembly of claim 26, wherein the housing further comprises a recess configured to receive a portion of said member when the source-backing surface is in close proximity to the source-contact surface.
32. The assembly of claim 26, wherein said member has a first end proximal to a front panel of the housing and a distal end that extends at least to a distal edge of a platen.
33. The assembly of claim 26, wherein the flap is coupled to the housing with at least one post assembly having a plurality of spatially-separated detent positions.
34. The assembly of claim 26, wherein the member moves relative to the source-contact surface when an operator adjusts the source-backing surface in relation to the source-contact surface to increase the width of the aperture.
35. The assembly of claim 26, wherein the width of said member varies over the length of the member.
36. The assembly of claim 26, wherein said member is coated with a material having a relatively low coefficient of friction.

37. A method for arranging a source in a scanner comprising:

horizontally inserting a leading edge of the source into an aperture formed by a member that protrudes from a housing such that a second edge of the source, different from the leading edge, is supported by a base of said member, said base having a width that varies along the length of the member; and

adjusting the source such that the information desired to be imaged is aligned with the sensor.

38. The method of claim 37, further comprising:

inserting a plug into a slot formed in a flap, the flap substantially parallel with the platen of the scanner; and

enabling the sensor to scan the information.

39. The method of claim 38, further comprising:

removing the plug; and

removing the source from the aperture.

40. A space-saving scanner assembly, comprising:

a housing having a substantially vertical source-contact surface;

a flap coupled to the source-contact surface, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing; and

a support member interposed between said housing and said flap and extending to a front panel of the housing, wherein the source-contact surface, the source-backing surface, and said support member form an aperture for horizontally receiving a source to be scanned without necessitating relative movement between the flap and the housing.

41. The assembly of claim 40, wherein a portion of the vertical source-contact surface of the housing comprises a platen to permit scanning of a source document in a vertical position.

42. The assembly of claim 41, wherein the platen has an upper edge, an opposing lower edge, a front edge relatively coexistent with a front panel of the housing, and a distal edge and wherein said support member is adjacent to the lower edge of the platen.

43. The assembly of claim 42, wherein said support member has a distal end that extends at least to the distal edge of the platen.

44. The assembly of claim 42, wherein the width of said support member varies.

45. The assembly of claim 40, wherein said housing comprises a front panel having an inclined surface adjacent to the aperture.

46. The assembly of claim 40, wherein the flap comprises an inclined surface adjacent to the aperture.

47. The assembly of claim 40, wherein the flap comprises a slot.

48. The assembly of claim 47, wherein the slot is positioned to permit the placement of a relatively short source document on edge on said support member wherein information to be scanned is aligned with at least a portion of a platen.

49. The assembly of claim 40, wherein the flap is coupled to the housing with at least one post assembly having a plurality of spatially separated detent positions.

50. The assembly of claim 40, wherein the flap is coupled to the housing with at least one adjustable fastener for closely contacting the source-backing surface to the vertical source-contact surface.

51. The assembly of claim 40, wherein the source-backing surface of the flap comprises a clip arranged to receive a portion of a source document to be scanned.

52. The assembly of claim 40, wherein the housing further comprises a recess configured to receive a second member of said support member when an operator closely adjusts the source contact surface to the substantially vertical surface of the housing.

53. The assembly of claim 52, wherein the member moves relative to the vertical source-contact surface when an operator adjusts the source-backing surface in relation to the vertical source-contact surface of the housing to increase the width of the aperture.

54. The assembly of claim 40, wherein said support member is coated with a layer of material having a relatively low coefficient of friction.

55. A space-saving scanner assembly, comprising:
means for housing an optical scanning means; and
means for forming an aperture configured to closely receive a leading edge of a source transferred horizontally along a plane substantially orthogonal to a front surface of the means for housing, such that the source can be spatially arranged with the optical scanning means without adjusting the aperture, the source being supported along a second edge of said source by a support means in the aperture, said support means extending to a front panel of the means for housing, wherein said support means is interposed between a first source-retaining means and said optical scanning means.

56. The assembly of claim 55, wherein said support means comprises a second source retaining means substantially parallel to the optical scanning means.

57. The assembly of claim 55, wherein the first source retaining means comprises a flap having a slot.

58. The assembly of claim 55, wherein the means for forming an aperture comprises a first inclined surface associated with said means for a housing and a second inclined surface associated with the first source retaining means.

59. A method for saving space on a desktop, comprising:
providing an optical scanner within a housing, the housing having a substantially vertical source-contact surface with a support member protruding from the housing, the support member extending to the exterior of the housing; and
providing a flap closely coupled to the source-contact surface, the flap, support member, and source-contact surface forming an aperture for receiving a source moved horizontally to be scanned.

60. The method of claim 59, further comprising inserting a leading edge of a source to be scanned into the aperture.

61. The method of claim 60, wherein inserting is accomplished absent relative movement between the flap and the housing.

62. The method of claim 61, further comprising enabling the optical scanner to scan the source.

63. The method of claim 62, further comprising removing the source from the aperture.

64. A space-saving scanner assembly, comprising:
a housing having a substantially vertical source-contact surface comprising a platen;
a flap coupled to the housing, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing; and
a support member interposed between the source-contact surface and the source-backing surface proximal to a perimeter segment of the platen, wherein the source-contact surface, the source-backing surface, and the support member form

an aperture for receiving a first edge of a source moved horizontally without necessitating relative movement between the flap and the housing to align a second edge of the source with the perimeter segment of the platen.

65. The assembly of claim 64, wherein the housing contains a front panel with an inclined surface adjacent to the aperture, the inclined surface arranged such that the aperture is larger adjacent to the front panel.

66. The assembly of claim 64, wherein the flap comprises an inclined surface adjacent to the aperture, the inclined surface arranged such that the aperture is larger adjacent to a front edge of the flap, wherein the front edge is substantially perpendicular to the source-backing surface.

67. The assembly of claim 64, wherein the flap comprises a slot.

68. The assembly of claim 67, wherein the slot is positioned to permit the placement of a relatively short source document on said support member and wherein information to be scanned from the source document is aligned with at least a portion of the platen.

69. The assembly of claim 64, wherein the housing further comprises a recess configured to receive a portion of said support member when the source-backing surface is in close proximity to the source-contact surface.

70. The assembly of claim 64, wherein said support member has a first end proximal to a front panel of the housing and a distal end that extends at least to a distal edge of the platen.

71. The assembly of claim 64, wherein the flap is coupled to the housing with at least one post assembly having a plurality of spatially-separated detent positions.

72. The assembly of claim 64, wherein the housing is configured to extend said support member from the source-contact surface when an operator adjusts the source-backing surface in relation to the source-contact surface to increase the width of the aperture.

73. The assembly of claim 64, wherein the width of said support member varies.

74. The assembly of claim 64, wherein an upper surface of said support member is coated with a material having a relatively low coefficient of friction.

75. A method for arranging a source in a scanner comprising:
horizontally inserting a leading edge of the source into an aperture formed by a support member interposed between a platen and a flap such that a surface of the source having information thereon that is desired to be imaged by the scanner is adjacent to a sensor arranged in a substantially vertical plane; and
adjusting the source such that the information desired to be imaged is aligned with the sensor.

76. The method of claim 75, further comprising:
inserting a plug into a slot formed in a flap, the flap substantially parallel with the platen of the scanner; and
enabling the sensor to scan the information.

77. The method of claim 76, further comprising:
removing the plug; and
removing the source from the aperture.

IX. EVIDENCE - APPENDIX

None.

IX. RELATED PROCEEDINGS- APPENDIX

None.